

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

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csl

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Willie B. Pinkney

v.

Treadwell's Drifters, Inc.

Opposition No. 91151984
against Application Serial No. 73807122,
filed June 16, 1989

James M. Slattery of Birch, Stewart, Kolasch & Birch, LLP for
Willie B. Pinkney.

Claude W. Roxborough of Kimmel & Roxborough, LLC for Treadwell's
Drifters, Inc.

Before Simms, Seeherman and Quinn, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

Willie B. Pinkney ("opposer") has opposed the
application of Treadwell's Drifters, Inc. ("applicant"), a

New Jersey corporation, to register the mark THE DRIFTERS for entertainment services in the nature of singing group.¹

In his notice of opposition, Mr. Pinkney alleges that he has previously used and is now using the mark Bill Pinkney's Original Drifters for entertainment services in the nature of live performances by a musical group. Opposer asserts ownership of an application to register that service mark (Serial No. 75469250). As grounds for opposition, opposer asserts that applicant's mark so resembles opposer's previously used mark as to be likely to cause confusion; that applicant's mark disparages and falsely suggests a connection with opposer; that applicant's officer falsely stated in the application that she knew of no one who had a right to use the mark THE DRIFTERS when in fact she knew that another had rights; and that applicant is not the owner of the mark sought to be registered because of opposer's prior use.

In its answer, applicant has denied the allegations of the opposition and has asserted that a court has enjoined the use of the mark Bill Pinkney's Original Drifters.

The record of this case consists of opposer's requests for admission, to which applicant did not respond,

¹ Application Serial No. 73807122, filed June 16, 1989, claiming use and use in commerce by a predecessor since 1953.

introduced by opposer's notice of reliance; five depositions (and related exhibits) taken by opposer; and the application file. Applicant did not take testimony, and only opposer filed a brief. No request for an oral hearing was filed.

In his testimony deposition, Mr. Pinkney stated that he began performing with THE DRIFTERS in 1953. He testified that since that date he has continuously performed with THE DRIFTERS or under the name Bill Pinkney & The Original Drifters. Pinkney dep., 6, 18. He also testified concerning an arbitration hearing and ruling made by the American Guild of Variety Artists. In that ruling, issued in the late 1950s, it was ruled that Mr. Pinkney could perform under the mark The Original Drifters. He testified that, since the date of that ruling, he has continuously used either The Original Drifters or Bill Pinkney's Original Drifters. Pinkney dep., 11.

Exhibits submitted with opposer's testimony show that a civil action (68-CVS-2630) was brought by The Drifters, Inc. against Mr. Pinkney. The record contains a copy of a barely legible order dated March 9, 1970, wherein the Superior Court Division of North Carolina, County of Mecklenburg, enjoined Mr. Pinkney from "using the name 'The Drifters' or 'The Original Drifters' or using as his trade

name any name including the name 'Drifters' and from using Plaintiff's distinct style and harmony, and from advertising as his own recordings Plaintiff's nationally popular records." According to his testimony, Mr. Pinkney stated that as soon as he became aware of the entry of this judgment, he moved to have it set aside. Opposer has also made of record a copy of an order dated October 26, 1993, whereby the same court dissolved the "Default Judgment and Permanent Injunction filed in this case and dated March 9, 1990 [sic, should be March 9, 1970]." That order also dismissed the suit brought by The Drifters, Inc.

Mr. Pinkney's testimony was corroborated by other witnesses. For example, Mr. Charlie Thomas testified that he has performed with Mr. Pinkney since the early 1960s under the name The Original Drifters. According to Mr. Thomas, Mr. Pinkney owns this mark.

Mr. Charles Cockerham testified that he began performing with Mr. Pinkney in November 1969 under the names The Original Drifters and Bill Pinkney's Original Drifters, and that they have continuously performed under those names across the country and overseas. In fact, the night before his deposition, Mr. Cockerham performed with Mr. Pinkney under the name Bill Pinkney's Original Drifters at the Vocal Hall of Fame.

Mr. Isiah Council testified that he started performing with The Original Drifters in November 1971, and that this name and Bill Pinkney's Original Drifters have been used continuously since that time. Mr. Council testified that Mr. Pinkney is the owner of these names.

Finally, Maxine Porter testified that she began performing with Mr. Pinkney under the name The Original Drifters in March 1988, and that, to her knowledge, Mr. Pinkney has performed under that name since 1959.

Exhibits introduced in connection with these depositions show photographs, advertisements, newspaper articles and listings of performances of Mr. Pinkney's group. These listings are for the years 1999-2003 under the name The Original Drifters. Some exhibits also show advertisements of the group under the name Bill Pinkney & The Original Drifters. See Exhibits 3, 6, 7 and 9 to Mr. Cockerham's deposition. Others show the use of The Original Drifters. See Exhibits 11, 12, and 15-18. Copies of performance contracts with Mr. Pinkney were also submitted. The group is usually identified as The Original Drifters in these contracts.

In his brief, opposer argues that he has standing by virtue of his performances as a member of the well-known singing group THE DRIFTERS since 1953, and by virtue of his

rights to use The Original Drifters and Bill Pinkney & The Original Drifters, which he has continuously used since that date. Also, opposer argues that this date long precedes the earliest date upon which applicant is entitled to rely in the absence of evidence--the June 16, 1989 filing date of its application. Opposer argues that his marks are substantially identical in appearance and significance to applicant's mark.

As to the other grounds, opposer argues, 10-11:

It is clear from the testimony taken by the Opposer that Treadwell's Drifters, Inc. did make false statements upon the filing of their [sic] application on June 16, 1989 in view of the fact that Ms. Treadwell knew of at least Willie B. Pinkney who had the right to use the mark, "THE DRIFTERS."

The use of the mark "THE DRIFTERS" by the Applicant will disparage and falsely suggest a connection with Opposer...

In view of the testimony taken by the Opposer, it has been established that the applicant is not the owner of the mark sought to be registered and, thus, not entitled to the registration sought in the opposed application.

Our determination of likelihood of confusion under Section 2(d) of the Act is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re E.I. du Pont de*

Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Two key considerations are the marks and the goods or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Upon consideration of this record and opposer's arguments, we agree that opposer has established by a preponderance of the evidence both his standing and his right to prevail under Section 2(d) of the Act. The record amply demonstrates that opposer has continuously used the service marks The Original Drifters and Bill Pinkney & The Original Drifters since long prior to applicant's filing date, the earliest date to which applicant is entitled to rely. See *Levi Strauss & Co. v. R. Josephs Sportwear, Inc.*, 28 USPQ2d 1464, 1467 (TTAB 1993). There is also little doubt that The Original Drifters and Bill Pinkney & The Original Drifters are substantially similar service marks to THE DRIFTERS, and that, if these marks were used on the identical entertainment services in the nature of a singing group, confusion would be likely.

Because opposer is entitled to prevail on the grounds of priority and likelihood of confusion, we need not

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address opposer's other claims, such as disparagement and false suggestion of a connection with opposer.

Decision: The opposition is sustained under Section 2(d) and registration to applicant is refused.